



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
07/130,070	12/08/87	WARD	D ENZ-1 (CONT) D

JAMES F. HALEY, JR.
FISH & NEAVE
875 THIRD AVE.
NEW YORK, NY 10022

EXAMINER	
CRANE, L	
ART UNIT	PAPER NUMBER
183	6

DATE MAILED:

07/16/90

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

for restriction purposes only.

☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire ---- Month(s), 30 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|--|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449 | 4. <input type="checkbox"/> Notice of informal Patent Application, Form PTO-152 |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474 | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 104-109, 113-118, 125-137, 140-144 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☒ Claims 1-103, 110-112, 119-124, 138, 139 and 145 have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☐ Claims _____ are rejected.
5. ☒ Claims 143-144 are objected to.
6. ☒ Claims 104-109, 113-118, 125-137, 140-142 are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.
8. ☐ Allowable subject matter having been indicated, formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. These drawings are ☐ acceptable;
☐ not acceptable (see explanation).
10. ☐ The ☐ proposed drawing correction and/or the ☐ proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved. ☐ disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.
12. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

130,070

Rev. 7-82)

EXAMINER'S ACTION

Art Unit 183

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group 180, Art Unit 183.

- 5 Applicant is requested to update the status of the parent application(s) in the instant case.

The disclosure is objected to because of the following informalities: the figures of claims **125 and 140** are not permanently attached to the pages of the submitted pre-amendments.

- 10 Appropriate correction is required.

- 15 Applicant is requested to note that claims **143 and 144** have not been included in the instant restriction requirement due to what appears to be an improper dependence of these claims from claim **142**. Applicant will note that this problem has apparently arisen due to the changes introduced into claim **142** by preliminary amendment.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- 20 I. Claims **125-137 and 142**, drawn to a method of hybridization, classified in Class 435, subclass 6.

Art Unit 183

II. Claims **104-109, 113-118, 140 and 141**, drawn to a method of detecting involving antibody binding, classified in Class 435, subclass 7.

5 The inventions are distinct, each from the other because of the following reasons:

10 Inventions I and II are related as subcombinations disclosed as useable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately useable. In the instant case, invention I has utility such as providing a starting material for the polymerase chain reaction, i.e. a primer hybridized with a target nucleic acid sequence. See MPEP 806.05(d).

15 Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their divergent classification, the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

20 A telephone call was made to Ms. Margaret A. Pierri on July 11, 1990 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in

Art Unit 183

compliance with 37 CFR 1.48(b) if one or more of the currently
named inventors is no longer an inventor if at least one claim
remaining in the application. Any amendment of inventorship must
be accompanied by a diligently-filed petition under 37 CFR 1.48(b)
5 and by the fee required under 37 CFR 1.17(h).

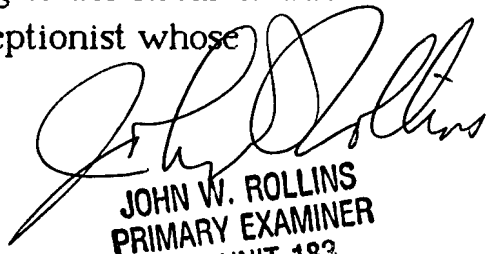
Applicant is advised that the response to this requirement to be
complete must include an election of the invention to be examined
even though the requirement be traversed (37 C. F. R. 1.143).

Any inquiry concerning this communication or earlier
10 communications from the examiner should be directed to Examiner L.
E. Crane whose telephone number is 703-557-3583 (new telephone
number).

Any inquiry of a general nature or relating to the status of this
application should be directed to the Group receptionist whose
15 telephone number is 703-557-0664..

LECRANE:lec 

7/13/90


JOHN W. ROLLINS
PRIMARY EXAMINER
ART UNIT 183